

### Remarks

An Office Action was mailed on October 29, 2004, at which time claims 1-7 were pending, of which claim 1 is the sole independent claim. Claims 8-18 were withdrawn due to a restriction requirement.

By the foregoing, claim 4 is amended and new independent claims 19 and 20 are presented.

Claims 1-5 and 7 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,774,168 to Blome in view of U.S. Patent No. 4,596,409 to Holbein et al. Claim 6 stands rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,774,168 to Blome in view of U.S. Patent No. 4,596,409 to Holbein et al. and in further view of U.S. Patent No. 4,597,592 to Maurer et al.

As the Examiner correctly points out, Blome discloses a multi-layered security product and Holbein discloses an all-plastic card. However, fundamental to the present invention is that unlike the known art, including Blome and Holbein, a carrier material and a plastic coating are joined together by extrusion. The resulting bond is significantly stronger than other possible structures, such as laminate structures, as detailed in the discussion of the prior art in the specification.

Extruding the plastic coating onto the carrier results in a structure that has a bond with an unobvious difference over the cited references of Blome and Holbein. In support thereof, Applicants submit a declaration of two of the inventors.

Pertinent to the present discussion is that the extruded plastic coating is able to have a significantly stronger bond than known in the art, where lamination is used. The Examiner is respectfully directed to the enclosed declaration.

As now made clear by the declaration, the inventors, who are all employed by an organization with a well earned reputation in the art and in particular the declarants who are each skilled in the art, decided to advance the art by enhancing the bond strength between two chosen layers. As further stated in the declaration, and as was previously argued, the bond produced by extrusion is stronger and more secure against counterfeiting. Therein, the present inventive structure has the

unobvious structural qualities resulting from a bond which is significantly stronger and that make the inventive security product superior to the known art.

Furthermore, as clearly stated in the declaration, those skilled in the art are limited in producing improvements to security products. As the declarants point out, the security products are essentially given away, often by millions to those who need or must carry them. Thus, improvements are confined by choices that must be highly cost effective and thus are in some ways incremental. This incremental difference is evidenced by joining two layers together in a manner that produces a structure that is unobviously different to the cited references.

For the foregoing reasons, the Examiner is requested to withdraw the rejection on the grounds of unobvious differences to the cited references.

A sample of a Specimen Passport is being submitted herewith. The sample includes an identity page for a fictitious "Erika Mustermann." The identity page is disposed as the first sheet inside the cover and extends beyond the fold to include a sectioned page.

Therein, the identity page comprises the claimed inventive structure. Specifically, the identity page comprises paper as a carrier material onto which a plastic coating has been firmly extruded to form a thin-gauged combination of layers. The Examiner is requested to note that this page is almost as thin as the paper pages that follow it and as the inventors point out in the enclosed declaration, the page feels almost like paper to a user. Declaration at Note 11. Laminated structures have a much thicker structure and feel artificial and obstructive in a security product and are not a thin-gauged structured as presently claimed in Claim 1.

The sample also illustrates the "laser-active plastic material that permits subsequent personalization with a laser." The plastic coating that has been extruded to the carrier, paper in this sample, consists of a laser-active material. Thus, all personal identifying features of Ms. Mustermann, namely Ms. Mustermann's image, signature, date and place of birth, nationality, passport number, and, indeed, the coded information at the bottom of the page, are produced by lasering the laser-active plastic material.

Applicants submit that the limitations of a “plastic coating being firmly extruded onto the acrid material”, “thin-gauged combination of layers”, “plastic coating” “consisting of laser active pigments” are not unanticipated and are unobvious over the references.

Notwithstanding the above arguments, Applicants believe that the Examiner's designation of the claimed subject matter of a product-by-process is incorrect. Applicants claim new product that in and of itself differs from the known structures by providing layers that are in a bonded relationship that is stronger than those taught, disclosed or reasonably suggested by the cited reference. In particular, this has been claimed as an extrusion in claim 1 and is also now claimed in a new claim, namely claim 19, as the limitation of a solidified melt. Both claims clearly and unequivocally define a structure that has different physical properties.

However, unlike a process that is concluded when the product is made, the bond is permanently present in the structure. Anyone investigating the nature of the inventive product would be able to test the product and note readily that the bond is present. Applicants submit that this meets the test of a structural limitation. In fact, Applicants respectfully submit the courts concur with this position. In *In re Garnero*, 412 F.2d 276, 162 USPQ 221, 223 (CCPA 1969), it was held that certain limitations may be structural rather than process oriented. Claim 1 included a limitation of perlite particles, which were interbonded with each other by interfusion. The CCPA stated, and in fact the MPEP 8th Ed. 2nd Revision now reports the same, that this recitation was capable of being construed as structural limitations and that the claims read over the cited art. In *Hazani v. United States Int'l Trade Comm'n*, 126 F.3d 1473, 44 USPQ2d 1358, 1363 (Fed. Cir. 1997 ) (additional citation omitted), the court found that the limitation of "chemically engraved" described a product and not a product-by-process.

Thus, Applicants submit that claims 1-7 and new claims 19 and 20 are indeed products that are directed to a structure and claim such and submit that the same are not product-by-process claims. Thus, the Examiner should give patentable weight to the limitations of “thin-gauged structure”, “extrusion” and “extruded.”

Thus, notwithstanding the above unobvious differences, Applicants submit that none of the cited references, individually or in any combination, teach, disclose, or reasonably suggest the claimed structure of claims 1 and 19. Specifically, the cited references do not disclose, teach or

reasonably suggest a multi-layer security product, comprising an extrusion defined by a carrier material firmly joined to at least one plastic coating; said at least one plastic coating being firmly extruded onto the carrier material to form a thin-gauged combination of layers and containing laser-active pigments that are doped to permit printing personalization by a laser such that said pigments become colored after laser exposure; and at least one covering film laminated onto the carrier material, as currently claimed in claim 1. Nor do the cited references disclose, teach or reasonably suggest a multi-layer security product, comprising a carrier material and a solidified melt joined by extrusion to the carrier material, nor the further limitations of claim 19. Accordingly as stated, the Examiner is kindly requested to reconsider the designation of claims 1-7 as product-by-process claims and withdraw the rejections for the above reasons.

In the alternative, the Examiner is requested to reconsider the interpretation for not granting patentable weight to the method of making the present inventive security product. A bedrock principle of U.S. patent law is that "anything under the sun" is patentable. Thus, Applicants should not be denied patent protection simply because the claimed product does not fit neatly into a category nor because of the limitations of the English language. As *In re Bridgeford*, 357 F.2d 679, 149 USPQ 55-57-58 (CCPA 1966) teaches regardless of how Applicant defines the invention, the applicant's right to a patent should not be diminished. Therein, certain limitations even if they are indeed directed to a process are in fact structural limitations because the result is a product of the process. *Atlantic Thermoplastics Co. v. Faytex Corp.*, 974 F.2d 1279, 23 USPQ2d 1801, 1803 (Fed. Cir. 1992) (Newman, J. dissenting).

Notwithstanding the above arguments, new claims 19 and 20 are presented. Claim 19 is directed to a security product having a solidified melt joined to a carrier material and new claim 20 is directed at an inventive web that includes an extrusion defined by a carrier material and a plastic coating layer joined. None of the cited references, individually or in any combination, teach, disclose or reasonably suggest such any of these structures.

The Examiner is requested to note the change in the Attorney Docket number to BDR 20.411 (021440-89777) and accordingly update the PALM system.

Applicant is also enclosing a copy of a U.S. Patent & Trademark Office stamped and returned postcard indicating that an IDS was submitted with the response of October 16, 2003. A copy of

the IDS as preserved in the applicants' file and bearing the signature of the attorney making the submission at the time is also enclosed. To avoid confusion that an IDS is being submitted at this time the documents are marked as copy. Copies of the foreign references being cited in the IDS are also submitted. The Examiner is respectfully requested to acknowledge the IDS and references listed therein.

All dependent claims are allowable for at least the same reasons as the independent claim from which they depend.

In view of the remarks set forth above, this application is in condition for allowance which action is respectfully requested. However, if for any reason the Examiner should consider this application not to be in condition for allowance, the Examiner is respectfully requested to telephone the undersigned attorney at the number listed below prior to issuing a further Action.

Applicants respectfully request return of the sample to the undersigned Attorney. Any fees due may be charged to Deposit Account 50-1290.

Any fees due, including any extension fees that may be due, this paper are may be charged to Deposit Account 50-1290.

Respectfully submitted,



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CUSTOMER NUMBER 026304  
Docket No.: BDR 20.411 (021440-89777)